REMARKS

Claims 1-66 are pending with claims 19-22 and 24-63 withdrawn from consideration for being directed to a non-elected invention. Claims 1-18, 23 and 64-66 are presently pending and under examination.

Claim 1 has been amended to correct the antecedent basis and to replace the phrase "nucleotides 400 to 500 of SEQ ID NO: 4" with the phrase "nucleotides 400 to 511of SEQ ID NO: 4." Support for the amendment to claim 1 is found throughout the application and the claims as filed, for example, at page 20, lines 8-19, and in Table 1.

Applicants previously elected Group I claims 1-18 and 23 on August 8, 2006. The Examiner has now issued a further restriction of Group I under 35 U.S.C. §121 based on Applicants' addition of new claims 64-66 in their response to the initial restriction requirement. In particular, the Examiner requires, at pages 2-3 of the Office Action mailed June 8, 2007, that Applicants elect one of antisense oligonucleotides designated SEQ ID NOS: 31-34 recited in claim 64. Applicants elect **SEQ ID NO: 33 with traverse**.

According to MPEP § 806.05(j), "[t]o support a requirement for restriction between two or more related product inventions... both two-way distinctness and reasons for insisting on restriction are necessary, i.e., separate classification, status in the art, or field of search." (citations omitted).

Related products are considered distinct when 1) the inventions as claimed are either not capable of use together or can have a ***materially different design, mode of operation, function, or effect***; 2) ***the inventions do not overlap in scope, i.e., are mutually exclusive***; and 3) the inventions as claimed are not obvious variants. *See* MPEP § 806.05(j) (emphasis added).

The Examiner has not withdrawn the initial restriction, but rather issued a further restriction of the group "that now contains claims 1-18, 23 and 64-66." (see current Office Action, page 2). The Examiner therefore concedes that claim 1 remains part of the elected invention of Group I. Applicants respectfully submit that a search of claim 1, necessarily encompasses a search of the antisense oligoucleotides recited in claim 64, which are species of the genus recited in claim 1. The antisense oligonucleotides designated SEQ ID NOS: 31-34 are encompassed in the scope of claim 1 and a subset of the genus of claim 1. It is respectfully

submitted that there is no extra burden on the Examiner to include the a search of the antisense oligonucleotides designated SEQ ID NOS: 31-34 in the search of Group I as presently elected since a search of claim 1 necessarily encompasses a search of claim 64.

Applicants further respectfully submit that the claimed antisense compounds share a common function, mode of operation as well as impart a common effect in inhibiting the expression of diacylglycerol acyltransferase 1. Furthermore, each of the compounds is targeted to at least an 8 nucleobase portion of nucleotides 400 to 511 of SEQ ID NO: 4 encoding diacylglycerol acyltransferase 1 and each specifically hybridizes to and inhibits the expression of diacylglycerol acyltransferase 1, providing a ***common structural feature linked to the common effect*** of inhibiting expression of diacylglycerol acyltransferase 1. Thus, while patentably distinct, the antisense oligonucleotides designated SEQ ID NOS: 31-34, do not have a materially different mode of operation, function and effect.

Further, the claimed antisense oligonucleotides hybridize to a specific region of the diacylglycerol acyltransferase 1 mRNA and SEQ ID NOS: 31-33 have immediately adjacent sequences. The claimed antisense oligonucleotides designated SEQ ID NOS: 31-34 each target a nucleic acid sequence that lies within a 111 nucleotide region of SEQ ID NO: 4 (nucleotides 400-511). Additionally, they each show at least 60 percent inhibition of diacylglycerol acyltransferase 1 mRNA (see Table 1 at page 76).

As explained above, the claimed antisense oligonucleotides are structurally and functionally similar and they belong to a scientifically recognized class of compounds (i.e. antisense oligonucleotides targeted to the diacylglycerol acyltransferase 1 of SEQ ID NO: 4). In *In re Harnisch* 206 USPQ 300 (CCPA 1980), the court determined that a group of coumarin compounds were structurally and functionally similar because all were dyestuffs, a classification that is not repugnant to scientific classification. The coumarins, while similar, did not have an identical structure as the Examiner appears to be requiring for the claimed antisense oligonucleotides. The Office's burden is not satisfied by observing that each member of the claimed genus is not identical. Furthermore, as determined in *Harnisch*, identity of structure and activity is not the proper test. The court determined the coumarin compounds need not have the identical properties, but rather they must have common properties, as the antisense oligonucleotides claimed herein possess.

Accordingly, Applicants respectfully request withdrawal of the requirement for election

of a single antisense oligonucleotide. Applicants believe that the foregoing comprises a full and complete response to the Office Action of record. Accordingly, an early Office Action on the merits of the case is respectfully requested.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 502624 and please credit any excess fees to such deposit account.

Respectfully submitted,

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